

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL
for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 180

Complete if Known

Application Number	09/905,338
Filing Date	July 13, 2001
First Named Inventor	Watkins, Michael I.
Examiner Name	Stucker
Art Unit	1648
Attorney Docket No.	02558B-059411US

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ MoneyOrder ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number

20-1430

Deposit
Account
Name

Townsend and Townsend and Crew LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.
FEE CALCULATION**1. BASIC FILING FEE**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	750	2001	375	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fees from below	Fee Paid
	** =		
Independent Claims	** =		
Multiple Dependent	X		

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1202	18	2202	9	Claims in excess of 20	
1201	84	2201	42	Independent claims in excess of 3	
1203	280	2203	140	Multiple dependent claim, if not paid	
1204	84	2204	42	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2)

(\$)

**For number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	410	2252	205	Extension for reply within second month	
1253	930	2253	465	Extension for reply within third month	
1254	1,450	2254	725	Extension for reply within fourth month	
1255	1,970	2255	985	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,300	2501	650	Utility issue fee (or reissue)	
1502	470	2502	235	Design issue fee	
1503	630	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Petitions related to provisional applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	180
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	750	2809	375	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	750	2810	375	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	750	2801	375	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid **SUBTOTAL (3)**

(\$180)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Joel G. Ackerman	Registration No. (Attorney/Agent)	24,307	Telephone	415-576-0200
Signature				Date	July 23, 2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. 60002964 v1

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/905,338
	Filing Date	July 13, 2001
	First Named Inventor	Watkins, Michael I.
	Art Unit	1648
	Examiner Name	Stucker
Total Number of Pages in This Submission	Attorney Docket Number	02558B-059411US

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard Communication Declaration Under 37 CFR 1.131
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual	Townsend and Townsend and Crew LLP	
Signature	Opel G. Ackerman	Reg. No. 24,307
Date	July 23, 2003	

CERTIFICATE OF HAND DELIVERY		
I hereby certify that this correspondence is being hand delivered to the Patent and Trademark Office on <u>July 24</u> , 2003		
Typed or printed name	Susie Kapeleris	
Signature	Susie Kapeleris	Date 7/24/03

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

CERTIFICATE OF HAND DELIVERY

PATENT

Docket No.: 02558B-059411US
Client Ref. No.: BRP00091 (divisional)

I hereby certify that this correspondence is being hand delivered to
the Patent and Trademark Office on July 24, 2003

On 7/24/03

By: Julie Kapeleris

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Michael I. Watkins and Richard B.
Edwards

Application No.: 09/905,338

Filed: July 13, 2001

For: MULTIPLEX FLOW ASSAYS
PREFERABLY WITH MAGNETIC
PARTICLES AS SOLID PHASE

Examiner: Stucker

Art Unit: 1648

COMMUNICATION

03 JUL 23 10:15
RECEIVED
COMMUNICATIONS SECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit herewith the enclosed Supplemental Information
Disclosure Statement and Declaration under 37 C.F.R. 131 for the Examiner's
consideration in the prosecution of this application. Both documents refer to PCT
published application WO 97/35210, also submitted herewith.

This application claims a composition of a plurality of particles of
magnetically responsive material suitable for use in a multiplex assay and comprising
subranges of particles distinguishable from one another by flow cytometry. The main
claim is claim 21, which reads:

09/25/2003 NVILLARI 00000005 201430 09905338

01 FC:1806 180.00 DA

21. A composition comprising a plurality of solid-phase assay reagents selectively active in a plurality of assays each for a different analyte, each said solid-phase assay reagent comprising a binding species that is selectively active in a single assay and coupled to one of a plurality of microparticles of magnetically responsive material, the sizes of said microparticles varying in size over a range that is an aggregate of a plurality of subranges, each subrange distinguishable from other subranges of said aggregate by flow cytometry and by the binding species coupled thereto, said microparticles being suitable for use in a multiplex assay procedure that includes the use of flow cytometry.

Submitted herewith is PCT application WO 97/35201, which has an effective date as a reference of September 25, 1997, its publication date. The reference generally discloses certain multiplex assays that use beads that are differentiable by size, shape and/or color (e.g., pp. 6-7). The beads are preferably made of some type of plastic, such as polypropylene, polystyrene or latex (p. 10). There is no statement in this reference that the beads under consideration by the inventors of that work had any magnetic properties. However, it is stated (p. 10) that the beads may be made "of other polymers or particles known in the art", and the specification states (p. 2 line 10) that magnetic beads (though of unspecified type) are known in the art, though that reference is to performing multiple single-antigen assays separately on a single sample rather than a multiplex assay (multiple simultaneous assays on the same sample).

The reference thus does not state as such that magnetic beads are among those types contemplated for use in the disclosed process. Applicants submit that those skilled in the art would, on reading the reference, not come to the conclusion that it discloses or renders obvious neither the types of magnetic particles claimed herein, nor their use in a multiplex assay. However, for completeness of the record, this reference is submitted for the Examiner's consideration in examining this Application.

Applicants also submit that, in any event this reference, which was published only about two months before Applicants' filing date, does not qualify as prior art under 35 U.S.C. 102(a). This position is based on the Declaration under Rule 131 submitted herewith, which clearly demonstrates that Applicants made their invention before the September 25, 1997 publication date of this PCT application.

CONCLUSION

In view of the foregoing, Applicants submit that the claims in this Application are allowable and request an early notice to that effect.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned.

Respectfully submitted,

Joel G. Ackerman
Reg. No. 24,307

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
JA:ja